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U. S. Patent and Trademark Office

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December 27, 2005 From:

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Keijiro TAKANISHI et al. 10/558275 Appl. No. Applicant

Confirmation No. 1653

November 23, 2005 1711 TC'A.U. Filed

Dac Truong PE-063 Olet. No. Examina

20374 3 Document transmitted herewith:

PACE 116 \* RCVD AT 12/27/2006 5:25:31 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-3/15 \* DNIS:2738300 \* CSID:202 887 0018 \* DURATION (mm-ss)-19.4

RESPONSE TO AND REQUEST FOR REMOVAL OF ELECTION OF SPECIES (LACK OF UNITY OF INVENTION) REQUIREMENT

(Due: December 27, 2006)

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P.I.D. William St. Bernard

PATENT

## IN THE UNITED STATES PATENT AND TRADEBARK OFFICE

Confirmation No. 1653 Setjiro TAKANISH et al. 10/558,275 Applicant : Appl. No.

November 23, 2005 1711 Examiner TC/A.J. Filed

Duc Truong

IPE-062 20374

Dkt. No.

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Renald J. Rubovetk

RESPONSE TO AND REQUEST FOR REMOVAL OF SIRCTION OF SPECIES

(LACK OF UNITY OF INVENTION) REQUIREMENT

PAGE 2/6 \* RCVD AT 12/27/2006 5:25:31 PM [Eastern Standard Time] \* SVR: USPTO-EFXRF-3/15 \* DNIS:2738300 \* CSID: 202 887 0018 \* DURATION (mm-s-5):0:194

Mail Stop Amendment Commissioner for Paterits P.O. Box 1450

Alexandria, VR 22313-1453

December 27, 2006

Sir

This paper is submitted in response to the Office Action dated November 27, 2016.

The Action requires election of one of the following species:

- a residue from phosphonic acid, <u>:</u>
- a residue from thiophosphonic acid, (2)
- a residue from selencphosphonic acid, 3

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PATENT APPLN. NO. 10/558,275 RESPONSE IO AND REQUESI FOR REXCYAL OF ELECTION OF SPECIES (LACK OF UNITY OF INVENIION) REQUIREMENT

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- (4) a residue from phosphonous acid,
- a residue from phosphoric acid,

<u>...</u>

- (6) a phosphorous containing residue of the claimed formula (2), and
- a phosphorous containing residue of the claimed formula
   (3).

Applicants elect Group (1) as the species. Claims 1 and 8 to 12 are believed to read on the elected species. This election is made with traverse or the basis that the Office has not properly shown a lack of unity of invention in the present application.

International application is the U.S. national stage of an international application. As noted in the action, unity of invention practice must be applied by the Office to the present application. The Office is taking the position that unity of invention is lacking under PCT Rule 13.1 because, under PCT Rule 13.2, the groups lack the same or corresponding technical feature because each species has a different chemical structure and requires a different search.

PACE 3/6 \* RCVD AT 12/27/2005 5:25:31 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-3/15 \* DNIS:2738300 \* CSID:202 887 0018 \* DURATION (mm-ss):014

Applicants respectfully submir that the Office has nor properly applied unity of invention practice. Species (1) to (5) are recited in claim 1 as a Markish group, According to Annex B of the Administrative Instructions under the FCT, in the case of

PAGE 416 \* RCVD AT 12/27/2006 5:25:31 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-3/15 \* DNIS:2738300 \* CSID:202 887 0018 \* DURATION (mm-ss):01-34

PATENT APPLIN. NO. 10/558,275
RESPONSE IO AND REQUEST FOR REXCVAL OF ELECTION OF SPECIES (LACK OF UNITY OF INVENTION) REQUIEEXENT

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The ď Markush groupings, unity of invention exists when the alternatives property and a common structure is present, i.e., a significant alternatives telong to a recognized class of chemical compounds in alternatives of a Markush grouping can be differently þ Office's position that the compounds of apecies (1) to (5) differ the art to which the invention pertains. Furthermore, the fact structural element is shared by all of the alternatives, or all in chemical structures and requires a different search does not Office must show that the compounds lack a common property and In the case of chemical compounds, ŝ show lack of unity of invention in the present application. justification for a finding of a lack of unity of invention. ಡ considered is present when all alternatives have ě alone, taken common. structural element. nature. not, a similar shall nature classified that the similar are cî

Notwithstanding the impropriety of the Office's position, applicants also submit that species (1) to (5) share a significant structural element. The atructure common to the species is a phosphorous atom and bicycloalkyl atructure, as illustrated below:

PATENT APPEN. NO. 10/558,275 RESPONSS TO AND REQUEST FOR REMOVAL OF ELECTION OF SPECIES (LACK OF UNITY OF INVENTION) REQUIREMENT

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(wherein R contains a bicyclotlkyl structure). Additionally, O, S and Se belong to the same group in the periodic table and have similar chemical properties (e.g., an optically low dispersability and a high refractive index).

olein 3, which recites a dependency or claim 2. Annex B of the S The Office has also falled to show lack of unity of invention which recites a dependency on claim 1. Species (7) is recited in Administrative Instructions under the PCT provides that unity of invention has to be considered in the first place only in relation to the independent plaims in an interrational application and not Consideration of unity of invention between an independent and dependent claim is in order only if an independent exist between an independent claim and all claims dependent claim does not avoid the prior art. The Office has not properly C regarding species (6) and (7). Species (6) is recited in claim 2, I.e., unity of invention is presumed and unity of invention regarding species (6) the dependent claims. shown lack of thereor.

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filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit

In the event that this paper is not considered to be

In the event any additional fees are required, please also

Accourt No. 111.833.

charge our Deposit Account No. 111833.

Respectfully summitted, KOBOVCIK

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Redald'I. Kubovetk Reg. No. 25,401

since the Office has not shown how claim 1, upon which the claims reciting species (6) and (7) ultimately depend, fails to avoid the

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ELECTION OF SPECIES

PAIEKT APPEN, NO. 10/559,275 RESPONSE TO AND REQUEST FOR REMOVAL OF (LACK OF UNITY OF INVENTION) REQUIREMENT

The foregoing is believed to be a complete and proper response

prior art.

is believed to If, however, minor issues remain that can be resolved by meace of a telephone interview, the Examiner is respectfully requested to contact the

place this application in condition for allowance. to the Office Action dated November 27, 2006, and

undersigned atterney at the telephone number indicated below.

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